

Application No. 10/686,511  
Filed: 10/14/2003

Office Action Date: 03/31/2006  
OA Response Date: 6/26/2006

### **REMARKS/ARGUMENTS**

Subsequent to the Office Action dated 03/31/06, claims 7-27 are allowed and claims 1-6 stand rejected under 35 U.S.C. §102(e) as being anticipated by *O'Neil et al.* (USPN 6,506,140). By this office action, claims 1-27 remain as originally submitted.

### **Allowable Subject Matter**

Applicants appreciate the acknowledgement of patentable subject matter of claims 7-27.

### **Claim Rejection – 35 U.S.C. §102(e)**

Claims 1-6 were rejected under 35 U.S.C. §102(e) as being anticipated by *O'Neil et al.* (USPN 6,506,140). Applicants respectfully traverse the rejections of claims 1-6.

As the examiner is likely well aware, anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. W.L. Gore & Associates. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Applicants respectfully traverse any rejection of Claim 1 in view of *O'Neil, et al.* because *O'Neil et al.* fails to anticipate each element of the rejected claims. Claim 1 of the present invention sets forth a multi-mode, electro-mechanical transmission including an input member coupled to a prime mover, at least one planetary gear set, at least one motor, at least one torque transfer device, a plurality of operating states and an output member, comprising: an open loop motor torque controller operative to control a preselected transmission speed to a target speed as a predetermined function of preselected transmission torques and accelerations. The motor is defined as an electrical motor (*See* Para. 0024), operative to supply a motor torque (*See* Para. 0041) which is open-loop controlled by a controller to a target speed (*See* Para. 0047).

*O'Neil et al.* disclose an internal combustion engine coupled to a torque converter coupled to an electronically controlled transmission with a plurality of selectable discrete gear ratios (*See*, Col. 2, Lines 18-32, referenced in the Office Action), wherein when the

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torque converter is locked, required engine torque (not speed) is set to a small negative value provided in an open loop mode without feedback (*See*, Col. 7, Lines 59-64, referenced in the Office Action.)

Specifically, and in contrast to the instant invention of claim 1, *O'Neil et al.* neither teach nor describe at least the following elements of the instant invention: an electro-mechanical transmission having at least one motor and an open loop motor torque controller which controls transmission speed to a target speed. The failure of *O'Neil et al.* to teach or describe any of these elements is sufficient to distinguish Claim 1 of the instant invention therefrom, under the law. Therefore, Claim 1 is patentably distinguishable from the teachings of *O'Neil, et al.*, and thus allowable.

The remaining claims 2-6 which stand rejected are all dependent - immediately or through intervening dependent claims - from claim 1 and add additional limitations thereto. As such, and for the reasons recited above with respect to claim 1, *O'Neil et al.* fail to provide adequate basis for the rejection thereof. Therefore, Applicants respectfully request withdrawal of all outstanding rejections of claims 1-6.

### Conclusion

It is respectfully submitted that all pending claims 1-27 are in condition for allowance and requested that same be allowed to proceed to issue. If the Examiner has any questions regarding the contents of the present response, the Applicants' attorney may be contacted at the phone number appearing below.

Respectfully Submitted,



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